Remarks

The applicant thanks the Examiner and SPE for the courtesy of an interview on June 8, 2006, to discuss the rejections based on the Segal reference. No agreement was reached, but the discussion of the Segal reference and the Examiner's suggestions to modify the format of claim 1 and to add active steps are appreciated.

This paper responds to the final Office action in the above-entitled application, mailed February 9, 2006, and allowing three months for a response. This response is timely because an extension of time of one month has been obtained.

The applicant will address all the points raised by the Office action and demonstrate that the present claims 1-64 are patentable for the reasons provided below. Reexamination of the application is therefore respectfully requested.

35 U.S.C. § 102 (Novelty)

The applicant has been asked to show that claims 1-2, 5-8, and 11-64 in this case are novel compared to the Segal et al. reference (US 2001/0041991). The applicant respectfully submits that these claims are novel because the present claims and the Segal reference differ.

Claim 1 is distinguished from the Segal reference at least because that claim recites:

"the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

A. inducing said patient to ~~obtain possession of a~~receive said medical record~~of said patient~~ from a covered entity; ~~acquiring~~

B. receiving said medical record from said patient in a storage format, without data processing said medical record; ~~and~~

C. storing said medical record in a memory in a form from which ~~it can be reproduced in said storage format.~~said medical record can be

> reproduced in said storage format, without data processing said medical record;
>
> D. obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and
>
> E. transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.,"

which the Segal reference does not teach. The underlined language is new. Similarly, claims 2-64, which contain similar limitations, are distinguished from the Segal reference.

The added language clarifies that a "service provider that is not the patient or a covered entity" is inducing the patient to receive the record from a covered entity (such as a physician or medical record storage or data processing facility) and performing other steps of the process. This new claim language makes clear that the service provider, the patient, and any medical professionals involved in making or maintaining the record are different parties. This amendment is believed to overcome the issues raised by the Office action in Section 6A starting on page 4 of the Office action of February 9, 2006. Each paragraph of Section 6A is individually discussed below.

The second paragraph of Section 6A, on page 4, states,

> In response, Examiner respectfully admits that Applicant fails to consider the full teachings of Segal. Examiner further submits that Segal does teach "inducing said patient to obtain possession of medical record of said patient from a covered entity.

Segal does not disclose any entity that is not the patient or a physician involved with a medical record inducing the patient to do the steps recited in the present claims. In contrast, the present claims require a "service provider" that is **not** a covered entity. This point will be explored in more detail below, in connection with the third, fourth, and fifth paragraphs of Section 6A.

The third paragraph of Section 6A, on pages 4-5, states,

> For example, Segal teaches that the physician (i.e., covered entity) directs and guides (i.e., induces) the patient to include specific medical information (i.e., medical record), originally omitted by the patient, within their master medical record (Segal: par. [0024] and [0027]). Moreover, Segal teaches that medical information includes an array of records including, but not limited to, scanned documents such as EKGs and medical images such as x-rays (Segal: par. [0023]). As such, the physician, upon determining that the patient has excluded certain x-ray imagery from their master medical record, would necessarily need to induce a patient to obtain possession of their x-ray imagery from a covered entity (i.e., medical office or hospital where the patient has been treated, which maintain records of that treatment) so that it could be delivered to the appropriate medical personnel for scanning and included within the patient's master medical record (Segal: fig. 4, 6 and 7a-7e; par. [0121]; Examiner considers x-ray imaging to be a procedure done exclusively by medical professionals rather than by the patient and therefore, a patient would need to be induced to undergo x-ray imaging and/or obtain possession of their x-ray images in order to complete the patient's master medical record. Furthermore, because Segal teaches that medical personnel scan a patient's medical imagery, rather than the patient, the patient would need to be induced to deliver their medical images to the medial personnel for scanning.).

In other words, the Office action is saying that in Segal the physician is inducing the patient.

The present claims do not allow the physician to induce the patient. A service provider other than the physician induces the patient. This distinguishes the present invention from Segal.

The fourth paragraph of Section 6A, on page 5, states,

> Examiner also respectfully submits that the concept of a covered entity inducing a patient to obtain possession of their medical records is notoriously well known and obvious as a standard operating procedure of medical facilities—this is particularly evident during the initial registration process of a new patient requesting medical services from a medical facility for the first time and when

> a patient is seeking a second opinion medical diagnosis so that the medical facility can establish the patient's medical history.

In this slightly different situation, the Office action is saying that a new physician or other medical professional has been known to induce the patient to obtain a record from a previously employed physician or other medical professional who possesses the record. No prior art has been cited for this situation.

The present claims distinguish this situation by identifying, as in claim 1, "a service provider that is not ... a covered entity." In this situation, (1) the covered entity such as a physician who made or otherwise has the record and (2) the covered entity such as another physician who is requesting the record are both covered entities. Professional (1) is supplying the information from his, her, or its medical records, and Professional (2) is inserting the information into his, her, or its medical records. Professional (2) is said to be inducing the patient. The present claims distinguish this situation as well, as the claimed service provider is not a covered entity.

The fifth paragraph of Section 6A, on pages 5-6, states,

> Lastly, Examiner considers the claim language "inducing said patient to obtain possession of a medical record of said patient from a covered entity" to include indirect/constructive inducement (e.g., medical facilities) and self-inducement (e.g., brought about by the patient himself or herself). As such, Examiner does not consider the term "induced" to be limited to inducement "caused by someone else" as Applicant has suggested.

Here again, the Office action is considering the possibility that the patient or a medical facility may induce the patient to act as claimed. As before, the amended claims exclude this possibility by requiring that the inducing service provider is not the covered entity (medical facility) and is not the patient.

Items 6(B), 6(C), 6(D) and the first two paragraphs of item 6(E) on pages 6 and 7 of the Office action refer back to item 6(A), and therefore are not believed to require separate comment.

Regarding the next paragraph of item 6(E) on page 7, the applicant has claimed the patient receiving a medical record. See e.g. claims 1(A), 19(A), and 30(A). The Office action's interpretation of "possession" as applying to records stored in a doctor's office or hospital goes beyond the broadest reasonable construction of the claims. Typically, the physician or hospital makes a medical record, owns it, and possesses it. The record is about the patient, and the patient is entitled to request and receive possession of a copy of the record (which is also a record in its own right), but the patient does not in any sense "possess" the record unless and until the patient requests and receives a copy from the physician. Part of the claimed invention is inducing the patient to request and receive a copy of the record from a covered entity. The use of the term "receive" in the claims clarifies that the patient is obtaining a record he or she did not previously possess – otherwise there would be little point in obtaining it.

Turning now to points discussed in the June 8 interview, Segal necessarily describes the service provider engaging in data processing, thus becoming a health care clearinghouse and itself a "covered entity." See paragraph [0034] of the present specification, providing the definition of a "health care clearinghouse:"

> A health care clearinghouse ("HCC") is a "public or private entity" that either "[p]rocesses or facilitates the processing of health information received from another entity in a nonstandard format or containing nonstandard data content into standard data elements or a standard transaction" or "[r]eceives a standard transaction from another entity and processes or facilitates the processing of health information into nonstandard format or nonstandard data content for the receiving entity." 45 C.F.R. .sctn. 160.103; see also 42 U.S.C. .sctn. 1320d(2) (defining "health care clearinghouse").

Processing health information from one format to another, under this definition, is data processing. For example, on page 8, paragraph [0103] of Segal, "keying the information [provided by the patient] into a new account in account database 132" is processing nonstandard format data (supplied by the patient on a form) into standard format data (in the database). On pages 11 and 12, paragraph [0143], the service provider "marks the information most critical for an emergency situation" and "duplicates this [marked]

information under the Global-ER tab as a single, concise GUI that displays this critical emergency data." Again, the system is processing medical data provided by the patient in a non-standard format by prioritizing certain information as needed in emergencies and concentrating that information in a particular place.

Therefore, even in the isolated passages relied on by the Examiner, Segal is data processing, thus distinguishing it from the present invention in which the service provider does not process data, but uses data as presented by the patient.

Finally, the Mok and Judson references, applied in other rejections in the first Office action, are not referred to in the present Office action, so no further comment respecting them is believed to be necessary. As the applicant pointed out in detail in Amendment A, Mok fails to show "inducing said patient to convert said medical record into a storage format," as recited in claim 1 and thus required by the rejected claims. Judson also fails to show either inducing step required by claim 1, an antecedent to the claims to which this reference was applied.

35 U.S.C. § 132 (Amendments Supported)

The amendments to independent claims 1, 19, and 30 reciting "a service provider that is not the patient or a covered entity" are supported, for example by paragraph [0043] of the specification as originally filed, which states, "the patient is induced to register and open an account with the service provider," and thus establishes that the patient and the service provider can be different people and/or entities. Further support is provided by Paragraph [0045], which states, "The Internet server 40 can be used to induce the patient to obtain his or her medical record from the covered entity 70." Paragraph [0040], the last sentence, adds, "The Internet server 40 may be located on the premises of an Internet medical storage service provider...." These passages establish as three separate people and/or entities the service provider, the patient, and the covered entity. See also the definition of the "service provider" at paragraph [0032]: "A "service provider" is a person or entity carrying out or assisting a patient or a third party to carry out the present

invention, where the service provided is one or more steps of the invention, or a software or hardware system that the patient or a third party can use to carry out one or more steps of the invention."

The limitations to actions taken by the service provider "without data processing said medical record" are supported at paragraph [0038]:

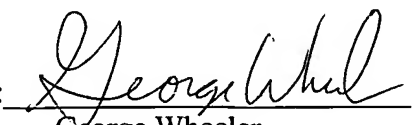
> In accordance with an embodiment of the invention, the medical information of a patient stored in a medical file storage system is provided by the patient, and is stored as the patient provides without any change or alteration to its content or format. In other words, a medical file storage system based on the present invention copies, stores, retrieves, and delivers medical information in the storage format as received from the patient, who obtained his or her own medical information from a covered entity. Such a medical file storage system is not a HCC because it does not process or faciliate the processing of health information received from a covered entity; it only receives and stores medical information of a patient that is provided by the patient himself or herself....

Steps D and E regarding obtaining agreement in advance to transmit information under defined conditions, then transmitting the information when the conditions occur, is supported for example at paragraphs [0052]-[0053] of the original specification as well as original claims 3 and 4.

The remaining amendments are antecedent references or minor variations of language. Therefore, the amendments do not introduce new matter.

Respectfully submitted,

Dated: June 9, 2006

By: 
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